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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,908	12/04/2001	Nissim Darvish	015/02481	3374

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EXAMINER

MANUEL, GEORGE C

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/980,908	DARVISH ET AL.	
	Examiner	Art Unit	
	George Manuel	3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-81, 83 and 84 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-80 of copending Application No. 10/048,803. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to obvious variations of transporting a molecule in a desired manner and a non-excitatory control effect for controlling activity, and programming to achieve a desired provision of the molecule into a patient's vasculature.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chance '081 in view of Lattin et al '609 and further in view of Aoki et al '397.

Chance teaches all of the claimed programming features. In addition, the examiner is interpreting the optical probe 14 to comprise a sensor for sensing a functional state of a non-cardiac tissue. Chance does not disclose the claimed features of the electric field transport device comprising drug delivery module 12. Lattin et al disclose the electrode structure that may be adaptable for use with drug delivery module 12. One of ordinary skill in the art would have found it obvious to combine the structural detail disclosed in Lattin et al for the drug delivery module 12 because Chance teaches the delivery device disclosed in Lattin et al may be substituted. See col. 7, line 59-63.

Chance in view of Lattin et al meet all of the claim limitations except for at least one of the electrodes comprising a pacing electrode.

Aoki et al teach an electrode used for iontophoresis may also be used for connecting bioelectrically stimulating devices such as pacemakers. One of ordinary skill in the art would have found it obvious to combine the teaching of Aoki et al with the electrode structure of Lattin et al because the Lattin et al electrode structure is intended to function for iontophoresis purposes.

Regarding claims 19, 36 and 63, one of ordinary skill in the art would have found it obvious to implant the electrode using a catheter because it is further well known in the pacing art to implant electrodes using a catheter.


Regarding claims 34, 40 and 41 the transport effect provided by the electrically induced transport may be either an excitatory or a non-excitatory field because Lattin et al teach the field produced may act on an agent that is either charged or uncharged.

Regarding claims 54 and 56, one of ordinary skill in the art would have found it an obvious modification to the electrode to shape it as either a spiral electrode or a mesh electrode because these shapes are well known in the pacing art.

Regarding claim 61, one of ordinary skill in the art would have found it an obvious modification to use a wireless electrode because Chance teaches the controller 16 includes a wireless interface and because the controller is connected by an RF coupler to drug delivery module 12.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Manuel whose telephone number is (571) 272-4952.


George Manuel
Primary Examiner
Art Unit: 3762

10/3/05